

REMARKS

Upon entry of the present amendment, claims 3, 18-19, 21-22, 25-26, and 28 will be pending in the application.

Claims 1, 2, 4-17, 20, 23-24, 27, and 29-41 have been canceled without prejudice.

Claim 3 has been amended to recite 10 to 89% by weight water. Support for this amendment can be found at least in the Specification as filed, page 76, line 4. No new matter has been introduced by this amendment.

Claims 3, 18-19, 21-22, 25-26, and 28 have further been amended to correct certain typographical errors and for proper antecedent basis. No new matter has been introduced by these amendments.

No claims have been added.

Amendments to and cancellation of the claims, as set forth above, are made in order to streamline prosecution in this case by limiting examination and argument to certain claimed embodiments that presently are considered to be of immediate commercial significance. Amendment or cancellation of the claims is not in any manner intended to, and should not be construed to, waive Applicant's right in the future to seek such unamended or cancelled subject matter, or similar matter (whether in equivalent, broader, or narrower form) in the present application, and any continuation, divisional, continuation-in-part, RCE, or any other application claiming priority to or through the present application, nor in any manner to indicate an intention, expressed or implied, to surrender any equivalent to the claims as pending after such amendments or cancellations.

Reconsideration is respectfully requested in view of the foregoing amendments and following remarks.

1. **Rejection of claims 3, 18-19, 21-22, 25-26, and 28 under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 6,403,701 to Reusmann et al., hereafter "Reusmann".**

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, or knowledge generally available in the art at the time of the invention, must provide some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1998).

As a preliminary matter, Applicant respectfully submits that Reusmann is directed to a mixer system **consisting of** A) a plurality of base colors A, which contain less than 5% by weight of water, at least one coloring and/or special-effect pigment, organic solvent, at least one water thinnable or water-dispersible first binder and, if desired, auxiliaries and additives, and B) at least one water-containing, pigment-free component B, comprising an aqueous dispersion of a polyurethane resin. (Reusmann, column 2, line 61, to column 3, line 3, emphasis added.)

That is, Reusmann's mixer system is close ended, and does not allow for any additional components other than A and B. This is emphasized throughout Reusmann's disclosure by using the closed ended term "consisting of". See, for example, Reusmann, column 2, line 61, and column 11, line 64.

The Examiner alleges that Applicant's module (I) reads on Reusmann's component A, and that Applicant's module (III) reads on Reusmann's component B. The Examiner concedes that Reusmann does not disclose Applicant's module (II).

However, the Examiner asserts that "[t]he claimed component (A2) is expected in Reusmann invention. Because, Reusmann discloses that a coating composition can be based on a plurality=various of base colors (A) separately storing each of said base colors, [...]. Also a component (A) may contain from 20 to 80% by weight of at least one

water-thinnable or water-dispersible binder, [...]. A polyacrylate thickener in water is disclosed in Reusmann invention at column 16, lines 9-10. A worker in the art would add water-thinnable or water-dispersible binder with a desirable pigment to control=improve coatability property and control/correct color effect for an aqueous coating material. (4/2/2008 Office Action, page 5, first full paragraph, emphasis in original.)

Applicant respectfully disagrees. It is respectfully submitted that Reusmann discloses a closed ended system consisting of mixers A and B. Reusmann does not provide any teaching, suggestion, or motivation to add any other mixers besides A and B. The Examiner's alleged motivation is not supported by Reusmann, the latter disclosing a closed-ended system.

For example, the Examiner alleges that claimed component A2 is expected in Reusmann. This allegation is unsupported by Reusmann, the latter disclosing a closed-ended system consisting of A and B. That is, any additional components would not be expected in Reusmann.

The Examiner further states that the above allegation that A2 is expected in Reusmann is supported by Reusmann since component (A) in Reusmann may contain from 20 to 80% by weight of at least one water-thinnable or water-dispersible binder. Again, this allegation is without basis since Reusmann explicitly discloses that component (A) contains organic solvent and less than 5% by weight of water, among others. (Reusmann, column 2, lines 63-67.)

The Examiner further states that a polyacrylate thickener in water is disclosed in Reusmann invention at column 16, lines 9-10. A worker in the art would add water-thinnable or water-dispersible binder with a desirable pigment to control=improve coatability property and control/correct color effect for an aqueous coating material. Applicant respectfully submits that this allegation is without any basis or support. The polyacrylate thickener referred to by the Examiner at column 16, lines 9-10 in Reusmann is clearly and explicitly disclosed to be added to the pigment-free component B in Reusmann. There's no teaching or motivation in Reusmann to add pigment to the same.

In fact, Applicant respectfully asserts that the allegations brought forth by the Examiner regarding the suggestion or motivation to modify Reusmann to do as Applicant has done are merely conclusory statements, and are insufficient to establish a prima facie case of obviousness. Reusmann is explicit in disclosing that the mixer system consists of components A and B and nothing else, and does not provide any suggestion or motivation to add a third component comprising water soluble or dispersible binders, color pigments, 10 to 89% by weight water.

In this regard, the courts have held that "[a] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). "To find obviousness, the Examiner must 'identify a reason that would have prompted a person of ordinary skill in the art in the relevant field to combine the elements in the way the claimed new invention does.'" *Id.* In addition, "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, No. 04-1616 (CAFC March 22, 2006) citing *In re Lee*, 277 F.3d 1338, 1343-46 (Fed. Cir. 2002).

In addition to the foregoing, Applicant respectfully asserts that since Reusmann discloses a closed-ended system consisting of A and B, modifying Reusmann to include any additional mixers that are not within the scope of A and B would change the principle of operation of Reusmann. In addition, since Reusmann discloses a closed-ended system consisting of A and B, Reusmann teaches away from modifying it to include any additional mixers that are not within the scope of A and B.

In this regard, the courts have held that "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious." *In re Ratti* 270 F. 2d 810, 123 USPQ 349 (CCPA 1959). "A prima facie case of obviousness may also be rebutted by showing that the art, in any

material respect, teaches away from the claimed invention." *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997), emphasis added.

Therefore, Applicant respectfully asserts that in view of the above, independent claim 3 and all the claims depending therefrom are patentable over Reusmann under 35 U.S.C. §103(a). Reusmann does not teach or suggest all the elements of independent claim 3, as currently amended, and does not provide any motivation to modify Reusmann to arrive at Applicant's claims. The motivation provided by the Examiner is merely conclusory statements and is unsupported by Reusmann, the latter disclosing a closed ended system. In fact, Reusmann teaches away from the present claims, and the suggested modifications would change the principle of operation of Reusmann. Withdrawal of this rejection is respectfully requested.

In addition to the above, claim 22 recites that the modules comprise the at least one pigment-free rheology module (IV). That is, module (IV) is no longer optional as recited in independent claim 3. Therefore, claim 22 recites, in addition to the required three modules of claim 3, a fourth module free of pigment and comprising an aqueous medium, comprising at least one rheology control additive. Applicant respectfully asserts that claim 22 is further patentable over Reusmann at least because Reusmann does not teach or suggest Applicant's four separate modules as recited in claim 22 and the claims depending therefrom.

2. **Rejection of claims 3, 18-19, 21-22, 25-26, and 28 under 35 U.S.C. §103(a) as allegedly unpatentable over Reusmann in view of U.S. Patent No. 6,001,915 to Schwarte et al., hereafter "Schwarte".**

As discussed above and conceded by the Examiner, Reusmann does not teach or suggest Applicant's module (II). However, the Examiner relies on Schwarte to remedy the deficiencies in Reusmann. Applicant appreciates the detailed basis of rejection but must respectfully disagree.

The Examiner supports this position by stating that "any additional compound as a tinting base color comprising water-dilutable binder is expected in Reusmann invention." (4/2/2008 Office Action, page 6, second paragraph.)

Applicant respectfully asserts that this statement is incorrect and unsupported by Reusmann. Reusmann discloses a system consisting of components A and B. That is, Reusmann's system is closed ended and does not allow for the inclusion of any components that are not within the scope of A and B. Any statement otherwise is a mere conclusory statement and unsupported by Reusmann. Modifying Reusmann by combining it with Schwarte would change the principle of operation of Reusmann, the latter explicitly excluding systems such as that of Schwarte.

Applicant respectfully asserts that in making this rejection, the Examiner is merely stating that the present claims are obviated by the prior art by alleging that the individual components of the claims are disclosed separately in the prior art without articulating or providing a sound technical basis as to why one with ordinary skill in the art would be motivated to perform such modifications. In this regard, the courts have held that "A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). To find obviousness, the Examiner must "identify a reason that would have prompted a person of ordinary skill in the art in the relevant field to combine the elements in the way the claimed new invention does." *Id.*

In view of the above, Applicant respectfully asserts that the independent claim 3 and all the claims depending therefrom are patentable over the combination Reusmann and Schwarte, at least because there is no suggestion or motivation to combine Schwarte with Reusmann, and because such combination would render Reusmann unsatisfactory for its intended purpose, the latter teaching away from including any mixer systems other than A and B. Withdrawal of this rejection is respectfully requested.

In addition to the above, claim 22 recites that the modules comprise the at least one pigment-free rheology module (IV). That is, module (IV) is no longer optional as recited in independent claim 3. Therefore, claim 22 recites, in addition to the required three modules of claim 3, a forth module free of pigment and comprising an aqueous medium, comprising at least one rheology control additive. Applicant respectfully asserts

that claim 22 is further patentable over Reusmann and Schwarted at least because the combination of Reusmann and Schwarte does not teach or suggest Applicant's four separate modules as recited in claim 22 and the claims depending therefrom.

3. Rejection of claims 3, 18-19, 21-22, 25-26, and 28 under 35 U.S.C. §103(a) as allegedly unpatentable over Reusmann, in view of EP 0 081 994 to Kawakami et al., hereafter “Kawakami”.

The Examiner relies on Kawakami to remedy the above described deficiencies in Reusmann. However, Applicant respectfully asserts that there is no suggestion or motivation for the combination of Kawakami with Reusmann, nor is there a reasonable expectation of success. In fact, such a combination would be improper for at least the following reasons.

Firstly, Applicant respectfully asserts that Reusmann teaches away from combining it with Kawakami, as discussed above. Reusmann is a closed ended system consisting of A and B. Thus, one with ordinary skill in the art would not be motivated to include another system that is not within the scope of A and B.

Secondly, modifying Reusmann by combining it with Kawakami would render Reusmann unsuitable for its intended purpose, at least because Reusmann requires a closed ended system of A and B, however combining it with Kawakami introduces an additional component that is outside the scope of A and B.

Thirdly, Reusmann is directed to coating compositions having improved condensation resistance. (Reusmann, column 1, line 8-10). For the transition from conventional to water-thinnable systems, therefore, it is not sufficient simply to exchange the binders used for water thinnable binders. (Reusmann, column 1, lines 54-57). In recent times, the requirements for water and moisture resistance, especially for condensation resistance, of automotive refinishes have risen. (Reusmann, column 2, lines 35-37).

Therefore, Reusmann teaches that utilizing water-based coating compositions requires the binders to have improved condensation resistance. This improved condensation resistance is provided by Reusmann's binder only. Using any other water

thinnable binder, such as that in Kawakami, would not be sufficient to meet the automotive OEM requirements for water and moisture resistance, and especially for condensation resistance.

Reusmann then discloses that it has surprisingly been found that the condensation resistance of finished coatings produced from the mixer systems of the general type described in DE-A4110520 can be increased considerably if the mixing component B) described therein has added to it as binder, a polymer which is obtainable by subjecting an ethylenically unsaturated monomer or a mixture of ethylenically unsaturated monomers to free-radical polymerization in the presence of a water-insoluble initiator and in an aqueous dispersion of a polyurethane resin which has a number-average molecular weight of between 1000 and 30,000 Daltons and on average from 0.05 to 1.1 polymerizable double bonds, wherein the weight ratio between the polyurethane resin and the ethylenically unsaturated monomer or monomer mixture is between 1:10 and 10:1. (Reusmann, column 2, lines 43-58).

Therefore, Reusmann teaches that achieving improved condensation resistance in aqueous systems over the prior art can be effected by utilizing Reusmann's component (B), and only Reusmann's component (B). That is, a component comprising, as binder, a polymer which is obtainable by subjecting an ethylenically unsaturated monomer or a mixture of ethylenically unsaturated monomers to free-radical polymerization in the presence of a water-insoluble initiator and in an aqueous dispersion of a polyurethane resin which has a number-average molecular weight of between 1000 and 30,000 Daltons and on average from 0.05 to 1.1 polymerizable double bonds, wherein the weight ratio between the polyurethane resin and the ethylenically unsaturated monomer or monomer mixture is between 1:10 and 10:1.

Kawakami discloses a thermosetting resin prepared by mixing or reacting an alkylene diamine or polyalkylenepolyamine with an epihalohydrin, and a water-soluble resin obtained by reacting urea, a polyalkylenepolyamine, and a dibasic carboxylic acid and reacting the resultant polyamidopolyurea formaldehyde. (Kawakami, abstract). Kawakami's resin is thus substantially different from Reusmann's binder (B).

Therefore, Applicant respectfully asserts that there is no motivation to combine the above references because according to the teaching of Reusmann, one with ordinary skill in the art would be discouraged to use a binder other than Reusmann's binder (B) in aqueous compositions, expecting such a binder to give inferior results (no expectation of success), since it would not be as resistant to condensation as that of Reusmann. Kawakami's binder would be a "mere substitution of a conventional binder with a water miscible binder", which, as discussed above, is discouraged by Reusmann. Kawakami's binder would act to "dilute" the advantageous effects of using Reusmann's binder in an aqueous solution, and thus someone with ordinary skill in the art would not be motivated to do as such when Reusmann explicitly teaches that non-Reusmann type water thinnable binders are inadequate for use in the disclosed applications since they will not provide the appropriate condensation resistance (see above).

In response to arguments, the Examiner asserts that Applicant is arguing that Kawakami and Reusmann are not analogous art. (4/2/2008 Office Action, page 8, final paragraph.) Applicant respectfully asserts that this is incorrect, and that Applicant argued that the combination of Reusmann and Kawakami is inappropriate because there is no teaching or suggestion for such a combination. In addition, as discussed above, such a combination would render Reusmann unsuitable for its intended purpose, and Reusmann teaches away from such a combination by requiring a closed-ended system consisting of A and B.

In view of the above, Applicant respectfully asserts that independent claim 3 and all the claims depending therefrom are patentable over the combination of Reusmann and Kawakami. Withdrawal of this rejection is respectfully requested.

In addition to the above, claim 22 recites that the modules comprise the at least one pigment-free rheology module (IV). That is, module (IV) is no longer optional as recited in independent claim 3. Therefore, claim 22 recites, in addition to the required three modules of claim 3, a forth module free of pigment and comprising an aqueous medium, comprising at least one rheology control additive. Applicant respectfully asserts that claim 22 is further patentable over Reusmann and Kawakami at least because the

combination of Reusmann and Kawakami does not teach or suggest Applicant's four separate modules as recited in claim 22 and the claims depending therefrom.

Applicant further traverses the remaining assertions set forth in the office action, including the teachings of the various references. However, since these references fail to render the claims obvious for at least the reasons set forth above, these assertions are moot and are therefore not specifically addressed in detail.

CONCLUSION

Applicant respectfully submits that the Application and pending claims are patentable in view of the foregoing amendments and remarks. A Notice of Allowance is respectfully requested. As always, the Examiner is encouraged to contact the Undersigned by telephone if direct conversation would be helpful.

Respectfully Submitted,

/MaryEGolota/
Mary E. Golota
Registration No. 36,814
Cantor Colburn LLP
(248) 524-2300

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CORRESPONDENCE ADDRESS ONLY

BASF CORPORATION
1609 Biddle Avenue
Wyandotte, MI 48192
Customer No. 26922

MEG/IK